

Appl. No. 10/521,955
Docket No. EBA-0022

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REMARKS / ARGUMENTS

Status of Claims

Claims 1-8 are pending in the application and stand rejected. Applicant provides herein clarifying remarks and has added new Claims 9-11, leaving Claims 1-11 for further consideration.

Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Rejections Under 35 U.S.C. §103(a)

Claims 1-5, 7 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baginski (U.S. Patent No. 6,192,802, hereinafter Baginski) in view of Parat et al. (U.S. Patent No. 5,877,927, hereinafter Parat).

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Baginski in view of Parat and Avery et al. (U.S. Patent No. 6,501,632, hereinafter Avery).

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that obviousness cannot be supported by a proposed modification that would render the prior art invention being modified unsatisfactory for its intended purpose. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984); MPEP §2143.01.

Additionally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As such Applicant also respectfully submits that "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." *In re Werner Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing: *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Dir. 1998); *In*

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re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984). There must also be a reasonable expectation of success in modifying or combining the prior art, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 USPQ2d 1016, 1023 (Fed. Cir. 1996). And, there must be some degree of predictability in showing the reasonable expectation of success. *In re Rinehart*, 189 USPQ 143 (CCPA 1976); MPEP §2143.03.

The Examiner acknowledges that Baginski is deficient in anticipating the claimed invention, especially with respect to disclosure of the claimed timer portion being connected to the clamping portion and to the input nodes and being particularly responsive to the claimed input signals, and looks to Parat to cure this deficiency.

In alleging obviousness, the Examiner states that "It would have been obvious... to have *modified* the Baginski solution by *replacing* the zener diodes by the transistor ESD protection clamping circuit *according to the teachings of Parat*". Paper 20070216, pages 2-3 (Emphasis added).

Applicant respectfully disagrees, asserting that Baginski modified by Parat as alleged by the Examiner would render the modified Baginski unsatisfactory for its intended purpose, and therefore would not offer any such motivation to do so.

In comparing Baginski with the claimed invention, Applicant finds Baginski to teach the use of diodes D1 (132) and D2 (133) to shunt the firing signal *when the input signal* at terminals 140 *exceeds the turn-on voltage* of the diodes (col. 16, lines 39-57, discussing Figures 11A and 11B) (emphasis added). Applicant also finds Baginski to teach repeatable and predictable firing voltages of, for example, 2.0 volts *while electrostatic discharge (ESD) events greater than 2.1 volts are safely shunted* (col. 18, lines 9-12) (emphasis added). As such, Applicant finds Baginski to be concerned with *efficiently shunting ESD events above a defined threshold regardless of when they occur*.

In comparing Parat with the claimed invention, Applicant finds Parat to teach the use of a timer circuit 130 to shunt to ground voltages applied to input 100 for a

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predetermined length of time each time an input voltage is applied to input 100, regardless of the level of input signal, and that if an input voltage at input 100 persists for longer than the predetermined length of time, the input voltage is applied to circuit 110 after the expiration of the predetermined length of time, *again regardless of the level of input signal* (col. 2, lines 59-67, discussing Figure 1) (emphasis added). Applicant also finds Parat to teach timer circuit 130 being productive of a control signal at node 254 for turning the clamp circuit 120 on or off, where this control signal is a function of time from initiation of an input signal but is *independent of the level of the input signal* (col. 4, lines 35-52, discussing Figure 2) (emphasis added). As such, Applicant finds Parat to be concerned with *merely delaying* the passage of an input signal to circuit 110, rather than shunting the signal *based upon the level of the signal*. *Regardless of the level of the input signal at 100*, Applicant finds the timer circuit 130 to delay application of this signal to circuit 110 until a predetermined length of time has passed.

In using Parat to modify Baginski as alleged by the Examiner, by replacing the Baginski diodes with the Parat clamp circuit 120 and timer circuit 130, Applicant submits that Baginski would no longer be suitable for its intended purpose, *as the only time a signal shunt would occur (for a predetermined length of time) would be upon initiation of a signal at the input 100*, which Applicant submits is contrary to the intended purpose of Baginski (Baginski is intended to be responsive to an excessive input signal *regardless of when that excessive signal may occur*, such as at the time of initiation or otherwise). As modified by Parat, the modified Baginski would only be responsive upon *initiation of an input signal for a predetermined length of time*. This substantial change in performance in the modified Baginski, Applicant submits, is absolutely contrary to the intended purpose of Baginski.

In view of the foregoing, Applicant submits that one skilled in the art would not be motivated to use Parat to modify Baginski as alleged by the Examiner, as such a modification (responsive *only upon initiation* of an input signal) would render Baginski absolutely unsatisfactory for its intended purpose (responsive to an excessive input signal

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regardless of when that excessive signal may occur). As such, Applicant submits that a prima facie case of obviousness has not and cannot be established.

In addition to the foregoing, Applicant submits that the references lack a reasonable expectation of success in using Parat to modify or be combine with Baginski, determined from the vantage point of the skilled artisan at the time the invention was made.

In using Parat to modify Baginski as alleged by the Examiner, by replacing the Baginski diodes with the Parat clamp circuit 120 and timer circuit 130, Applicant submits that the modified Baginski still would not have a reasonable expectation of successfully performing as the claimed invention performs, as the timer circuit 130 of Parat, absent the VCC override circuit 140 of Parat, would have unexpected results with respect to the proper functioning of the Parat timer circuit 130 (the timer circuit 130 and VCC override circuit 140 are connected via a jumper between transistors 210, 220, which is also connected to ESD clamp circuit 120). By merely replacing the Baginski diodes with only a portion of Parat, Applicant finds the timer circuit 130 and the clamp circuit 120 to be missing signal input from the VCC override circuit 140, and therefore submits that no reasonable expectation of success can be established.

On the other hand, if the Examiner chooses to allege that Baginski could be modified by employing all of the circuitry of Parat, including the VCC override circuit 140, then Applicant submits that such a modification is very much substantially different from the claimed invention, as the combination would now perform like the Parat invention, which has been applied against the claimed invention only as a secondary reference, and therefore is impliedly substantially different from the claimed invention.

For at least the foregoing reasons, Applicant submits that the combination of Baginski and Parat lack a reasonable expectation of success in arriving at the claimed invention and performing as the claimed invention performs, and therefore cannot be used to establish a prima facie case of obviousness.

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In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to offer any reasonable expectation of success in combining the References to perform as the claimed invention performs, fail to teach a modification to prior art that does not render the prior art being modified unsatisfactory for its intended purpose, and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

Regarding New Claims 9-11

Applicant has added new Claims 9-11 to capture originally disclosed but unclaimed subject matter. No new matter has been added as antecedent support can be found in the application as originally filed, such as: at Paragraph-[0014] (discussing limit of bridge current to no more than 0.5 A during a clamping interval in response to a 1 A initiation signal) in relation to Claim 9; at Paragraph-[0013] (discussing response of the initiation element) in relation to Claim 10; and at Paragraph-[0012] (discussing relationship between clamping interval and duration of a proper initiation signal) in relation to Claim 11.

In comparing Baginski and Parat with the claimed invention of Claims 9-11, Applicant submits that the combination of references fails to teach or suggest each and every element of the claimed invention arranged so as to perform as the claimed invention performs, and therefore cannot support a prima facie case of obviousness. As such, Applicant submits that Claims 9-11 are allowable, and respectfully requests notice thereof.

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If a communication with Applicant's Attorneys would assist in advancing this case to allowance, the Examiner is cordially invited to contact the undersigned so that any such issues may be promptly resolved.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 06-1130.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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